

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 3-11, and 13-19 are presently pending in this case. Claims 1, 5, 6, and 11 are amended, new Claim 19 is added, and Claims 2 and 12 are canceled without prejudice or disclaimer by the present amendment. As amended Claims 1, 5, 6, and 11 and new Claim 19 are supported by the original disclosure,¹ no new matter is added.

In the outstanding Official Action, Claims 1-4, 7-10, and 11-18 were rejected under 35 U.S.C. §101; Claims 1-3, 5-7, 11-13, and 15 were rejected under 35 U.S.C. §102(b) as anticipated by Odamura (U.K. Patent Application Publication No. 2 360 912); and Claims 4, 8-10, 14, and 16-18 were rejected under 35 U.S.C. §103(a) as unpatentable over Odamura in view of Negishi et al. (U.S. Patent No. 6,504,089, hereinafter "Negishi").

With regard to the rejection of Claims 1-4 and 6 under 35 U.S.C. §101, it is respectfully submitted that Claim 1 (and Claims 3, 4 and 7-10 dependent therefrom) includes the physical elements of "a database," "search means," "control means," and "a display." Claim 11 includes the physical elements of "a database," "a search unit," "a control unit," and "a display." Thus, Claims 1, 3, 4, 7-11, and 13-18 clearly recite machines. In particular, the exemplary embodiment shown in Figure 5 of the present application includes display 17, a physical element.

With regard to the assertion in the outstanding Office Action that "a display can be created in software form,"² it is respectfully submitted that a display is a physical element and cannot be "created with software." In this regard, MPEP §2106.01 states that "Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed **as part of an otherwise statutory manufacture or**

¹See, e.g., the specification at page 20, line 18 to page 21, line 14 and Figures 13 and 14.

²See the outstanding Office Action at page 9, line 1.

machine. In such a case, the claim **remains statutory irrespective of the fact that a computer program is included in the claim.**” (Emphasis added.) In the present case, the claims recite an otherwise statutory machine that includes elements that may include software. Thus, such claims **remain statutory.**

Accordingly, Claims 1, 3, 4, 7-11, and 13-19 are believed to be in compliance with all requirements under 35 U.S.C. §101.

With regard to the rejection of Claims 1, 5, 6, and 11 as anticipated by Odamura, that rejection is respectfully traversed.

Claim 1 recites in part:

a database storing a plurality of text data with at least a first length;
search means for searching the database for at least one piece of text data with the first length, based on an input search key;
a display including a display area configured to display text data from the database, the display area having a width;
control means for obtaining partial text data with a second length that is smaller than the first length and corresponding to the width of the display area, out of the at least one piece of text data found by the search means, from the database, and to display the partial text data on the display area; and
scrolling means for horizontally scrolling display of the partial text data and remaining text data on the display area after receiving a command from a user, the remaining text data being all the text data other than the partial text data, the scrolling means obtaining the remaining text data from the database and automatically horizontally scrolling the remaining text data after the partial text data.

Odamura describes a client terminal 204 that downloads web pages from a server over the Internet for display on a display of a terminal 204. If a webpage is too tall to display on the display of the terminal, the client terminal breaks up the webpage vertically into multiple

pages.³ The additional pages are stored at a base station until the client terminal requests the additional pages.⁴

The outstanding Office Action cited the client terminal 204 breaking up a webpage into multiple pages of Odamura as “control means” as recited in Claim 2.⁵ However, it is respectfully submitted that Odamura only describes a device for breaking up a webpage in the **vertical** direction (and **not** the horizontal direction) into multiple web pages and providing these webpages when requested. Thus, Odamura does not teach any means for **horizontally scrolling** display of the partial text data **and** remaining text data on the display area after receiving a command from a user, the remaining text data being all the text data other than the partial text data, the scrolling means obtaining the remaining text data from the database and **automatically horizontally scrolling the remaining text data after the partial text data** as recited in amended Claim 1.

The outstanding Advisory Action dated May 7, 2008 stated that the adjustment of the data transmitted by the base station in Odamura to be in accordance with the capacity of the display on the display unit (in the vertical direction) “inherently teaches the ability of the display unit to display data according to its capacity, which is not constrained to any certainly and thus be capable of scrolling.” However, providing data adjusted to fit in a screen in a vertical direction is irrelevant to scrolling data in a horizontal direction. Further, such an allegation is not a proper inherency rejection which requires that evidence or reasoning be provided to show that the device of Odamura **necessarily** includes all of the features recited in Claim 1, not simply “capable” of such features. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings

³See Odamura, page 23, line 2 to page 24, line 3 and Figures 8-11.

⁴See Odamura, page 12, lines 4-21.

⁵See the outstanding Office Action at page 4, lines 12-18.

of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). (Emphasis in original). See MPEP §2112. In the present case, it is respectfully submitted that no evidence or reasoning has been provided to show that the device of Odamura *necessarily* includes all of the features recited in Claim 1.

Thus, it is respectfully submitted that Odamura does not teach, either explicitly or inherently, “control means” and “scrolling means” as defined in Claim 1. Consequently, Claim 1 (and Claims 3, 4, 7-10, and 19 dependent therefrom) is not anticipated by Odamura and is patentable thereover.

Claims 5 and 6 recite in part “horizontally scrolling display of the partial text data and remaining text data on the display area after receiving a command from a user, the remaining text data being all the text data other than the partial text data, the horizontally scrolling including obtaining the remaining text data from the database and automatically horizontally scrolling the remaining text data after the partial text data.” As noted above, Odamura does not describe, either especially or inherently, any *horizontal scrolling* of text data. Therefore, Odamura does not teach “horizontally scrolling display of the partial text data and remaining text data” as defined in Claims 5 and 6 other. Consequently, Claims 5 and 6 are not anticipated by Odamura and are patentable thereover.

Claim 11 recites in part:

a database configured to store a plurality of text data with at least a first length;

a search unit configured to search the database for at least one piece of text data with the first length based on an input search key;

a control unit configured to obtain partial text data with a second length that is smaller than the first length and corresponding to a width of a display, out of the at least one piece of text data found by the search unit, from the database, and to display the partial text data on the display; and

a scrolling unit configured to horizontally scroll display of the partial text data and remaining text data on the display area after receiving a command from a user, the remaining text data being all the text data other than the

partial text data, the scrolling unit configured to obtain the remaining text data from the database and to automatically horizontally scroll the remaining text data after the partial text data.

As noted above, Odamura does not teach any device configured to horizontally scroll display of partial text data and remaining text data as recited in amended Claim 11. Thus, it is respectfully submitted that Odamura does not teach "a scrolling unit" as defined in amended Claim 11. Consequently, Claim 11 (and Claims 13-18 dependent therefrom) is not anticipated by Odamura and is patentable thereover.

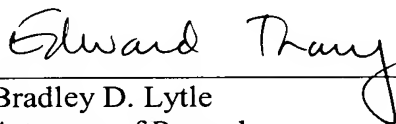
With regard to the rejection of Claims 4, 8-10, 14, and 16-18 as unpatentable over Odamura in view of Negishi, it is noted that Claims 4, 8-10, 14, and 16-18 are dependent from Claims 1 and 11, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Negishi does not cure any of the above-noted deficiencies of Odamura. Accordingly, it is respectfully submitted that Claims 4, 8-10, 14, and 16-18 are patentable over Odamura in view of Negishi.

New Claim 19 is supported at least by the specification at page 21, lines 7-14 and Figure 14. As new Claim 19 is dependent from Claim 1, new Claim 19 is patentable for at least the reasons described above with respect to this Claim 1.

Accordingly, the pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)

Edward W. Tracy, Jr.
Registration No. 47,998